

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

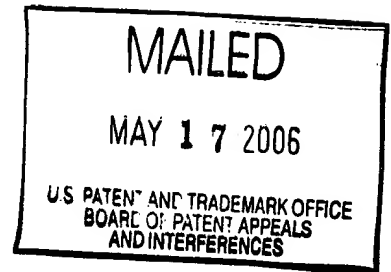
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte AMIR DORON

Appeal No. 2006-0569  
Application No. 09/360,419

ON BRIEF



Before JERRY SMITH, RUGGIERO, and SAADAT, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the Examiner's rejection of claims 11-19 and 21-25, which are all of the claims pending in this application. Claims 1-10 and 20 have been canceled.

The claimed invention relates to a method and apparatus for selectively generating still or motion images with a digital camera. A first sequence of high resolution still image files or a second sequence of low resolution image files are selectively generated and stored in memory in accordance with a predetermined still image data compression standard. Upon selectively retrieving the low resolution image files from memory, the image

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files are, by utilizing firmware, converted to a motion video sequence in accordance with a predetermined motion image data compression standard and stored.

Claim 11 is illustrative of the invention and reads as follows:

11. A method of selectively generating still or motion images with a digital camera, comprising the steps of:

selectively generating a first sequence of high resolution still image files or a second sequence of low resolution still image files and storing the image files in the memory in accordance with a predetermined still image data compression standard;

selectively retrieving the low resolution image files from the memory;

converting the low resolution image files to a motion video sequence in accordance with a predetermined motion image data compression standard, the conversion being performed with firmware; and

storing the motion video sequence.

The Examiner relies on the following prior art:

Parulski et al. (Parulski)	5,440,343	Aug. 08, 1995
Kato et al. (Kato)	6,148,031	Nov. 14, 2000
		(filed Nov. 26, 1997)
Inoue et al. (Inoue)	6,226,449	May 01, 2001
		(filed Apr. 17, 1997)
Tamura et al. (Tamura)	6,771,896	Aug. 03, 2004
		(filed Oct. 02, 1998)

"Digital Still Camera Image File Format Standard (Exchangeable image file format for Digital Still Cameras: Exif) Version 2.1" (Exif 2.1), JEIDA (June 12, 1998).

Claims 11-19, 21, and 25 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers Parulski

in view of Kato with respect to claims 11-14, 16-18, and 21-23, adds (Exif 2.1) to the basic combination with respect to claim 15, adds Inoue to the basic combination with respect to claims 19 and 24, and adds Tamura to the basic combination with respect to claim 25.<sup>1</sup>

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs<sup>2</sup> and Answer for the respective details.

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

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<sup>1</sup>Although the Examiner's statement of the rejection (Answer, page 3) includes claims 11-19 and 21-25 as being rejected over Parulski in view of Kato, it is apparent from the detailed description of the rejection that only claims 11-14, 16-18, and 21-25 stand rejected over the combination of Parulski and Kato.

<sup>2</sup>The Appeal Brief (second) was filed February 9, 2004 (Paper No. 25). In response to the Examiner's Answer mailed April 2, 2004 (Paper No. 26), a Reply Brief was filed June 7, 2004, (Paper No. 27), which was acknowledged and entered by the Examiner as indicated in the communication dated June 22, 2004 (Paper No. 29).

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 11-19 and 21-25. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying

with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to independent claims 11 and 21, Appellant's arguments in response to the Examiner's 35 U.S.C. § 103(a) rejection assert a failure to establish a prima facie case of obviousness since the Examiner has not established proper motivation for the proposed combination of references. Appellant further contends that, even if combined, all of the claimed limitations would not be taught or suggested by the combination of prior art references.

Initially, Appellant contends (Brief, page 6; Reply Brief, page 2) that, in contrast to the claimed invention, Parulski is not concerned with the compression encoding of images, nor the selective retrieval of low resolution images from storage. We agree with Appellant that the disclosure of Kato is primarily directed to the structure of an image sensor which permits different aspect ratios for motion and still image modes with only a nominal disclosure of the processor and recording units.

Similarly, we agree with Appellant (Brief, pages 6 and 7; Reply Brief, pages 2 and 3) that Kato, while generally disclosing the benefits of JPEG and MPEG compression techniques, is directed to the selective recording of a single high resolution still image from a motion picture sequence.

The claimed invention, however, requires the generation of a sequence of low resolution still image files for conversion into a motion video sequence.

With the above discussion in mind, we find no indication from the Examiner as to how and in what manner the Parulski reference would be combined with Kato to arrive at the claimed invention. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). In our view, given the disparity of problems addressed by the applied prior art references, and the differing solutions proposed by them, any attempt to combine them in the manner proposed by the Examiner could only come from Appellant's own disclosure and not from any teaching or suggestion in the references themselves.

We have also reviewed the Exif 2.1, Inoue, and Tamara references applied by the Examiner to address, respectively, the EXIF files, selective image display, and markup file features of several of the dependent claims. We find nothing in these references, however, which overcomes the innate deficiencies of Parulski and Kato as discussed supra.

In conclusion, since we are of the opinion that the prior art applied by the Examiner does not support the obviousness

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rejection, we do not sustain the rejection of independent claims 11 and 21, nor of claims 12-19 and 22-25 dependent thereon. Therefore, the decision of the Examiner rejecting claims 11-19 and 21-25 under 35 U.S.C. § 103(a) is reversed.

REVERSED

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Administrative Patent Judge

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